

REMARKS

In response to the Office Action dated September 16, 2005, the title has been amended as requested by the Examiner, and some of the suggested changes to the claims have been made. For the reasons discussed below, Applicants respectfully traverse the request to make the other suggested changes.

The Office Action requires withdrawn claims 5 and 25-39 to be canceled. It is noted that, of these claims, claims 27 and 29 depend from allowed claim 20. It is respectfully submitted that Applicants are entitled to maintain those two claims in the present application. Withdrawn claims 5, 25, 26, 28 and 30 have been canceled.

Claims 31-39, which were newly presented in the previous Amendment, were withdrawn from consideration, on the grounds that they were considered to be directed to an invention that is independent or distinct from the subject matter of the original claims. Applicants respectfully traverse this holding.

The Office Action characterizes the subject matter of claims 31-37 and the original claims as being a "product and process of use." It is respectfully submitted that the original claims are not directed to the process of *using* a product. Rather, the claims recite a method for manufacturing, i.e. making, smart cards. As such, it is respectfully submitted that the basis for insisting upon restriction is improper. Specifically, in an effort to identify a material difference, the Office Action states that "the process for *using* the product as claimed can be practiced with another materially different product instead of the product of Invention II as to form an electronic signaling antenna instead of the smart card" (emphasis added). However, claim 1 specifically recites "a method for manufacturing *smart cards*." Various

dependent claims among the original elected claims recite further details of the smart card manufacturing process. Note, for example, claim 4.

Thus, it is respectfully submitted that the Office Action does not identify a proper basis for requiring restriction. First, the original claims are directed to a method of making a product, not a method of using a product. The Office Action does not set forth a material distinction that applies to these two categories of claims. Second, the original claims are specifically directed to the manufacture of smart cards, and the Office Action has not shown that the claimed process can be applied to a product that is *materially different* from the subject matter of claims 31-37.

With respect to claims 38 and 39, the Office Action states that the subject matter of these claims "has separate utility such as by placing an IC circuit chip within the cavity so as to be [sic] electrical contact with the connection pads...." Again, it is respectfully submitted that this statement does not identify a *material* distinction over the subject matter of the original claims. For example, claim 4 recites the steps of "machining a cavity and connection recesses within an upper face of the card body," and "fixing an electronic module into the cavity, the module having on its lower side... conductive pads in electrical contact with the connection pads." Thus, the subject matter of claims 38-39 that is identified in the Office Action also appears in the original claims that have been examined.

For the foregoing reasons, therefore, it is respectfully submitted that the Office Action does not meet the requirement for a proper restriction between the two sets of claims. First, it does not identify a material distinction between the two sets of claims that would justify a restriction. Further, as shown by the foregoing, the subject matter of claims 31-39 that is identified in the Office Action is also present in the

original claims that have already been examined. As such, there is no additional burden on the Examiner to consider both sets of claims in the same application. Reconsideration and withdrawal of the restriction requirement is therefore respectfully requested.

The Office Action indicates that claims 4, 6-23 and 24 should be changed from "A method" to "The method." It is respectfully submitted that either form of claim terminology is acceptable. For instance, the Examiner is referred to M.P.E.P. §608.01(n), which gives several examples of acceptable dependent claim wordings. As can be seen, the exemplary claims begin with the indefinite article "A".

The Office Action suggests that the term "with ends or" in claim 1 should be changed to "with ends which are affixed to connection pads." In the implementation of the invention, it is possible that the turns of the antenna can terminate at locations where they are connected to the IC chip, without the need for defined connection pads. In other words, the contact pads of the chip could lie directly on the ends of the antenna turns. As such, it is respectfully submitted that the suggested amendment to the claim would constitute an unnecessary narrowing of the scope of the protection to which the Applicants are entitled.

Claim 1 recites that the insulating bridge is disposed "on a surface of said turns that is away from said support sheet." Referring to Figure 2 of the application, for example, the turns 11 of the antenna rest on the upper surface of the support sheet 10. The claim recites that the insulating bridge is disposed on the surface of the turns that is away from the support sheet, i.e. the upper surface of the turns. It is respectfully submitted that the claim terminology is definite as presented, and clearly

describes the illustrated concept. Accordingly, it is respectfully submitted that the suggested changes in paragraphs 3(e) and (f) of the Office Action are not necessary.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reconsideration and withdrawal of the restriction requirement, and allowance of claims 1, 2, 4, 6-24, 27, 29 and 31-39 is respectfully requested.

Respectfully submitted,

BUCHANAN INGERSOLL PC

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By: 

James A. LaBarre

Registration No. 28,632

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620